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EXAMINER	
PENDERGRASS, KYLE M	

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2624	

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/897,647	BERKEMA ET AL.	
	Examiner	Art Unit	
	Kyle M Pendergrass	2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-35 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-35 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 06/29/01.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Eldridge et al. (EP 0 893 760).

Regarding claim 1, **Eldridge et al**. teach a method for serving a print by reference operation to print referenced content from a referenced location to a print device *(fig 4 & column 11:line 52 – column 12:line 7, a method for context-based transactions with tokens, i.e. references, between a portable device and a network)*, the method comprising steps of:

accepting *(fig 4, step s8", accepting a token, i.e. accepting a reference)*, from a print client *(fig 1, PDA 2)*, a reference to print content targeted for printing from a location indicated by the reference *(column 9:line 44 – column 10:line 2, & column 8:lines 6-7, token/reference contains a URL for retrieval of a document located at address of URL)*;

resolving the reference to determine the location indicated by the reference *(fig 4, step s15 and column 12:lines 54-58, token/reference is decoded to determine URL)*;

obtaining print data from the location indicated by the reference *(fig 4, step s16, document data is retrieved using URL provided by token/reference)*;

transcoding the print data into a print device ready format *(fig 4, step s18, print data is converted to a format that matches printer capability)*;

allowing access to print data transcoded by said step of transcoding *(fig 4, step s19, access to converted print data is allowed because it has been sent to the printer)*;

transferring, in response to a request from the print client, print data transcoded by said step of transcoding *(fig 4, step s19, print data is transferred, which is a result of the initial request from PDA 2 to the network)*.

Regarding claim 2, **Eldridge et al**. teach the method according to claim 1, wherein said step of accepting accepts the reference from an Internet connection to the print client *(column 8:lines 2-5, a referenced document is processed by way of the internet)*.

Regarding claim 3, **Eldridge et al**. teach the method according to claim 1, wherein the reference comprises a universal resource locator address that addresses print content targeted for printing *(column 12:lines 57-58, document identifier comprises a URL)*.

Regarding claim 4, **Eldridge et al**. teach the method according to claim 1, wherein said step of accepting accepts a reference list of individual references that each reference print content stored at a location *(column 3:line 53 – column 4:line 2 recites a method of decoding a token with multiple references to documents stored at other locations, column 8:lines 6-7, referenced by a URL)*.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Eldridge et al. (EP 0 893 760).

Regarding claim 5, **Eldridge et al**. teach the method according to claim 4, wherein said steps of resolving, obtaining, transcoding, and allowing are completed for individual references, but do not explicitly teach wherein said steps of resolving, obtaining, transcoding, and allowing are completed for a first one of said individual references in said reference list before being conducted for another one of said individual references in said reference list.

However, serial and parallel processing are well-known in the art, therefor an inventor skilled in the art would combine the token with multiple references taught by **Eldridge et al.** with serial processing because it allows the retrieval of multiple documents to be accomplished.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Eldridge et al. (EP 0 893 760) & Petteruti et al. (US 6 379 058).

Regarding claim 6, **Eldridge et al**. teach the method according to claim 1, wherein the print client initiates control communication *(fig 5, step s2')*, but does not teach the method further comprising a step (emphasis added) of *initiating* a control communication *with* the print client.

However, **Petteruti et al.** teach the method further comprising a step of initiating a control communication with the print client *(column 6:lines 24-25)*.

Accordingly, it would have been obvious to one skilled in the art at the time of the invention to have used the control communication initiated with the print client as taught by **Petteruti et al**. in the method of **Eldrigde et al**. because it provides a method for additional functionality wherein the portable device is not the only device that initiates control communication.

Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eldridge et al. (EP 0 893 760) & Petteruti et al. (US 6 379 058) as applied to claim 6 above, and further in view of W3C (Simple Object Access Protocol (SOAP) 1.1) & Gase (US 6 184 996).

Regarding claims 7 & 8, **Eldridge et al. & Petteruti et al.** teach the method according to claim 6, but do not teach wherein said step of initiating a control communication is conducted via the Simple Object Access Protocol, an argument resolution protocol, and said steps of accepting and transferring are conducted via the HTTP protocol, a data transfer protocol.

However, **W3C** teaches the Simple Object Access Protocol (SOAP) *(page 5, section 2, **W3C** teaches using SOAP for transmissions between a sender and a receiver, in this case a control communication initiator and the print client).*

Accordingly, it would have been obvious to one skilled in the art at the time of the invention to have used the SOAP taught by **W3C** to initiate control communication in the method taught by **Eldridge et al. & Petteruti et al.** because (**W3C**, page 26, section 6, SOAP can be binded to HTTP, providing the advantage of being able to use the formalism and decentralized flexibility of SOAP with the rich feature set of HTTP.

Additionally, **Gase** teaches a HTTP protocol used for data transfer in a print-by-reference system similar to that taught by **Eldridge et al**. *(column 1:lines 26-35).*

Accordingly, it would have been obvious to one skilled in the art at the time of the invention to have used the HTTP protocol taught by **Gase** in the method taught by **Eldridge et al., Petteruti et al. & W3C**, because it allows for data transfer over the World Wide Web (***Gase**, column 11:lines 27-29),* and it would compliment the use of the SOAP.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Eldridge et al. (EP 0 893 760) & Holtzman et al. (US 6 400 272).

Regarding claim 9, **Eldridge et al.** teach the method according to claim 1, but do not teach the method further comprising steps of: accepting a security challenge from the location indicated by the reference; and responding to the security challenge.

However, **Holtzman et al**. teach a security challenge method for accessing requested information over a network connection, wherein, *column 13:lines 30-31*, a security challenge from the location indicated by the referenced information is accepted by the client, and responding to the security challenge involves prompting the resolve of the PIN request to the user.

Accordingly, it would have been obvious to one skilled in the art at the time of the invention to have used the secure access method taught by **Holtzman et al**. in the document/information retrieval system taught by **Eldridge et al.** because it would provide authentication access for secure document access in the **Eldridge et al** system.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Eldridge et al. (EP 0 893 760) & Holtzman et al. (US 6 400 272) as applied to claim 9 above, and further in view of Hull (US 6 772 338).

Regarding claim 10, **Eldridge et al. & Holtzman et al**. teach the method according to claim 9. Additionally, **Holtzman et al.** teach the concept of passing the security challenge (i.e. PIN request mentioned above in claim 9 rejection) to the request, but **Eldridge et al.** do not teach wherein said step of responding comprises passing the security challenge on to the print client.

However, **Hull** teaches a method (*fig 2)* wherein information is passed from an office appliance 201 (i.e. the workstation 50 taught by **Eldridge et al.**) to a shuttle memory service 202 (i.e. PDA 2 taught by **Eldridge et al.**).

Accordingly, it would have been obvious to one skilled in the art at the time of the invention to have used the method of information transfer taught by **Hull** in the method for secure document retrieval

taught by **Eldridge et al. & Holtzman et al**. because it would provide a method to forward the PIN request taught by **Holtzman et al.** to the user of the PDA taught by **Eldridge et al.**

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Eldridge et al. (EP 0 893 760) & Iwata (US 6 778 289) & Hull (US 6 772 338).

Regarding claim 11, **Eldridge et al.** teach the method according to claim 1, but do not teach wherein said step of allowing comprises: establishing a universal resource locator address for the print data transcoded by said step of transcoding; and communicating the universal resource locator address for the print data to the print client.

However, **Iwata** teaches establishing a universal resource locator address for the print data that the server system manages, and communicating the universal resource locator address for the print data to a print client *(column 5:lines 50-56, server defines URL for documents it manages and sends it to a print client)*.

Accordingly, it would have been obvious to one skilled in the art at the time of the invention to have used the **Iwata** method for defining a URL of each document managed by a print server in the method for document retrieval taught by **Eldridge et al.** because it would define a URL for the transcoded document that the server system manages, allowing for other devices, i.e. print clients, to access the document using the URL.

Furthermore, **Eldridge et al.** do not teach said step of sending the URL to the print client.

However, **Hull** teaches a method *(fig 2)* wherein information is passed from an office appliance 201 (i.e. the workstation 50 taught by **Eldridge et al.**) to a shuttle memory service 202 (i.e. PDA 2 taught by **Eldridge et al.**).

Accordingly, it would have been obvious to one skilled in the art at the time of the invention to have used the method of information transfer taught by **Hull** in the method for URL document retrieval

taught by **Eldridge et al. & Iwata**. because it would provide a method to forward the URL taught by **Iwata** to the user of the PDA taught by **Eldridge et al.**

Claims 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eldridge et al. (EP 0 893 760) & Srinivasan (US 6 452 689).

Regarding claim 12, **Eldridge et al.** teach the method according to claim 1, but do not teach the method further comprising a step of conducting a financial clearance.

However, **Srinivasan** teaches a method further comprising a step of conducting a financial clearance *(column 3:lines 48-65, billing system 19 verifies financial clearance and debits the account, i.e. billing ID)*.

Accordingly, it would have been obvious to one skilled in the art at the time of the invention to have used the billing method taught by **Srinivasan** in the method for document processing and retrieval taught by **Eldridge et al.** because it allows for billing of the service to the user.

Regarding claim 13, **Eldridge et al.** teach the method according to claim 1, but do not teach the method further comprising a step of requiring a billing ID from the print client.

However, **Srinivasan** teaches a method further comprising a step of requiring a billing ID from the print client *(column 3:lines 48-65, billing system 19 verifies financial clearance and debits the account, i.e. billing ID)*.

Accordingly, it would have been obvious to one skilled in the art at the time of the invention to have used the billing method taught by **Srinivasan** in the method for document processing and retrieval taught by **Eldridge et al.** because it allows for billing of the service to the user.

Claims 14, 16, 22-29, 32 & 34-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over the rejections for claims 1-13 set forth above.

Regarding claims 14, 16, 22-29, 32 & 34-35, **Eldridge et al** teach the methods taught in claims 1-13, but do not explicitly teach that the methods are realized as a computer program product comprising a computer usable medium having computer readable program code embodied in the medium.

However, it is well-known in the art to apply computer program products to methods and it is therefore obvious that the method taught by **Eldridge et al**. could be implemented in a computer product.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Eldridge et al. (EP 0 893 760).

Regarding claim 15, **Eldridge et al.** teach the print service according to claim 14, wherein the reference is accepted from a direct connection to the print client *(fig 1, PDA 2 uses RF of IR to make a direct connection)*.

Claims 17-19 & 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eldridge et al. (EP 0 893 760) & Srinivasan (US 6 452 689).

Regarding claim 17, **Eldridge et al**. teach the print service according to claim 14, wherein the internet is used for the print service *(column 8:lines 2-5)*, but they do not teach wherein the print service is a web site allowing the print service to be reached by the print client via the Internet.

However, **Srinivasan** teaches a print service as a web site allowing the print service to be reached by the print client via the Internet *(fig 1, web site 11)*.

Accordingly, it would have been obvious to one skilled in the art at the time of the invention to have used the web print service taught by **Srinivasan** in the system taught by **Eldridge et al.** because it

provides an effective system for printing document over the internet and it allows for billing of the service to the user.

Regarding claim 18, the claim rejection of claim 17 is representative of claim 18. See **Srinivasan** teachings wherein the web site is discoverable by the print client through the Internet *(fig 1 and column 12:lines 56-62, users discover the web site via the internet)*.

Regarding claim 19, the claim rejection of claim 18 is representative of claim 19. See **Srinivasan** teachings wherein the web site is pre-configured into print clients to be discoverable when print services are required by the print clients *(fig 1, users 10 discover the web site via the data network 12)*.

Regarding claim 21, the claim rejection of claim 18 is representative of claim 21. See **Eldridge et al.** teachings wherein the service is discoverable via network discovery protocols *(fig 5 steps s2'-s7')*.

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Eldridge et al. (EP 0 893 760) & Srinivasan (US 6 452 689).as applied to claim 18 above, and further in view of Olkkonen et al. (US 6 842 460).

Regarding claim 20, teach the print service according to claim 18, but do not teach a service registry to be discoverable by print clients.

However, Olkkonen et al. teach a discoverable service registry *(figs 5, service registry)*.

Accordingly, it would have been obvious to one skilled in the art at the time of the invention to have used the service registry taught by **Olkkonen et al.** in the web print service taught by **Srinivasan** & **Eldridge et al.** because it provides an effective system for registering services for a user near a network

Claims 30-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eldridge et al. (EP 0 893 760) & Petteruti et al. (US 6 379 058) & W3C (Simple Object Access Protocol (SOAP) 1.1) & Gase (US 6 184 996).

Regarding claim 30, the claim rejections for claim 27 are represented in claim 30. See **Gase** wherein the control communications create a new print job *(column 3:lines 6-9)*; check status of an existing print job *(fig 2, printer jobs list)*; and cancel an existing print job *(fig 4, printer job detail with CANCEL button 62)*.

Regarding claim 31, the claim rejections for claim 30 are represented in claim 31. See **Gase** wherein the print service accepts a request to create a new print job from the print client *(column 3:lines 6-9)*.

Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Eldridge et al. (EP 0 893 760) & Hull (US 6 772 338) & Reece et al. (US 5 915 214).

Regarding claim 33, **Eldridge et al.** teach the print service according to claim 14. **Eldridge et al.** do not teach said step of sending any document to the print client.

However, **Hull** teaches a method *(fig 2)* wherein information is passed from an office appliance 201 (i.e. the workstation 50 taught by **Eldridge et al.**) to a shuttle memory service 202 (i.e. PDA 2 taught by **Eldridge et al.**).

Accordingly, it would have been obvious to one skilled in the art at the time of the invention to have used the method of information transfer taught by **Hull** in the method for document retrieval taught by **Eldridge et al.** because it would provide a method to forward the document to the user of the PDA taught by **Eldridge et al.**

Additionally, **Eldridge et al.** do not teach wherein transcoding is done into a form that depends on a device type of the print client.

However, formatting information for compatibility in mobile devices it taught by **Reece et al.** *(column 7:lines 12-20).*

Accordingly, it would have been obvious to one skilled in the art at the time of the invention to have used the compatibility formatting function as taught by **Reece et al.** to send information to clients in the system for retrieving a document and sending it to a client as taught by **Eldridge et al. and Hull**, because it would assure that the document could be sent to the PDA without compatibility error.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kyle Pendergrass whose telephone number is **(571) 272-7438**. The examiner can normally be reached on Monday-Friday 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, King Poon can be reached on **(571) 272-7440**.

KING Y. POON
PRIMARY EXAMINER